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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/604,982
Filing Date: August 29, 2003
Appellant(s): FINDIKLI ET AL.

R. Brian Drozd
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 08/05/2008 appealing from the Office action mailed 11/21/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2003/00224823	HURST	12-2003
US 2002/0162016	COLVIN	10-2002

US 5,148,472 FREESE 09-1992

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 5, 6, 8-11, 16- 20, 26, 27, 29, 30, 32, 33, 36-39, 43 and 44 rejected under 35 U.S.C. 103(a) as being unpatentable over HURST et al (US 2003/0224823 A1) in view of COLVIN (US 2002/0162016 A1).

Regarding claim 1, HURST discloses a method of registering [OTA activation] a licensed module in a mobile device **100** (abstract), the method comprising: detecting the licensed software package in a processing platform in the mobile device being initially accessed by a user of the mobile device (Figure 5, 6, 8; paragraph 32, 35-37, 47-49, 56-58; subscription and software activation); collecting module parameters, the module parameters comprising at least a module identifier (paragraph 32, 35-37, 47-49, 56-58); assembling a registration message based on the detecting of the licensed software package being initially accessed, the registration message comprising at least the module identifier (paragraph 32, 35-37, 47-49, 56-58); and sending the registration message from the mobile device to a module registration system **710** corresponding to a destination address stored in the mobile device (paragraph 32, 35-37, 47-49, 56-58). However, HURST does not expressly disclose sending the registration message while allowing use of the licensed software package without requiring permission. In the

same field of the endeavor, COLVIN discloses sending a registration message to a module registration system while allowing use of a licensed software package without requiring permission so that the registering of the licensed software package is substantially transparent to the user (abstract; paragraph 31-34; Registration and authorization is provided transparent to the end user based on a counter. The system is recognizes authorized and unauthorized users and is able to take various actions including allowing the use of licensed software with or without requiring permission). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify HURST to include the transparent registration process taught by COLVIN, since such a modification would allow determination of use of shareware or timed software packages to be resolved automatically.

Regarding claim 2, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of HURST and COLVIN further discloses encrypting a data message prior to sending the data message (paragraph 21).

Regarding claim 3, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses further comprising receiving an acknowledgement message from the module registration system (paragraph 59).

Regarding claim 5, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses wherein the sending of the registration message further comprises sending the registration message using a short message service (SMS) (paragraph 57, 61, 62).

Regarding claim 6, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses wherein the registration message is a wireless application protocol (WAP) message and the sending of the registration message further comprises sending the registration message to a WAP server (paragraph 57, 61, 62).

Regarding claim 8, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses wherein the sending of the registration message further comprises sending the registration message using a short message service (SMS) (paragraph 57, 61, 62).

Regarding claim 9, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses wherein the registration message is a wireless application protocol (WAP) message and the sending of the registration message further comprises sending the registration message to a WAP server (paragraph 57, 61, 62).

Regarding claim 10, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses wherein the sending of the registration message further comprises sending the registration message using a short message service (SMS) (paragraph 57, 61, 62).

Regarding claim 11, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses wherein the registration message is a wireless application protocol (WAP) message and the sending of the

registration message further comprises sending the registration message to a WAP server (paragraph 57, 61, 62).

Regarding claim 16, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses further comprising selecting a delivery path for the registration message based on a delivery path parameter for the mobile device (paragraph 45-48, 57-59).

Regarding claim 17, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses further comprising selecting a delivery path for the registration message based on a delivery path parameter from among the module parameters (paragraph 45-48, 57-59).

Regarding claim 18, HURST discloses a mobile device **100** operable to register a licensed software package included therein (abstract), the mobile device comprising: means for detecting the licensed software package in a processing platform in the mobile device being initially accessed by a user of the mobile device (Figure 5, 6, 8; paragraph 32, 35-37, 47-49, 56-58; subscription and software activation); means for collecting module parameters, the module parameters comprising at least a module identifier (paragraph 32, 35-37, 47-49, 56-58); means for assembling a registration message based on the detecting of the licensed software package being initially accessed, the registration message comprising at least the module identifier (paragraph 32, 35-37, 47-49, 56-58); and means for sending the registration message from the mobile device so that the registering of the licensed software package is substantially transparent to the user of the mobile device (paragraph 32, 35-37, 47-49, 56-58).

However, HURST does not expressly disclose a means for sending the registration message while allowing use of the licensed software package without requiring permission. In the same field of the endeavor, COLVIN discloses sending a registration message to a module registration system while allowing use of a licensed software package without requiring permission so that the registering of the licensed software package is substantially transparent to the user (abstract; paragraph 31-34; Registration and authorization is provided transparent to the end user based on a counter. The system is recognizes authorized and unauthorized users and is able to take various actions including allowing the use of licensed software with or without requiring permission). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify HURST to include the transparent registration process taught by COLVIN, since such a modification would allow determination of use of shareware or timed software packages to be resolved automatically.

Regarding claim 19, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of HURST and COLVIN further discloses means for encrypting a data message (COLVIN – paragraph 21).

Regarding claim 20, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses further comprising means for receiving an acknowledgement message from the module registration system (paragraph 59).

Regarding claim 26, HURST discloses a mobile device **100** comprising: a radio frequency (RF) block for sending messages over a telecommunication network (Figure 5, 6, 8; paragraph 32, 35-37, 47-49, 56-58); and a processor platform for controlling the operation of the mobile device (paragraph 32, 35-37, 47-49, 56-58; a processing platform is inherently required in order to process over the air activation), the processing platform further comprising: at least one licensed software package including module parameters comprising a module identifier (paragraph 32, 35-37, 47-49, 56-58); and a module handler operable to collect the module parameters and cause a registration message to be assembled upon initial access of the at least one licensed software package by a user, the registration message comprising at least the module identifier in order to enable the registration of the at least one licensed software package (paragraph 32, 35-37, 47-49, 56-58); wherein the processing platform is further operable to cause the mobile device to send the registration message through the RF block to a module registration system **710** corresponding to a destination address stored in the mobile device so that the registering of the at least one licensed software package is substantially transparent to the user of the mobile device (paragraph 32, 35-37, 47-49, 56-58). However, HURST does not expressly disclose sending the registration message while allowing use of the licensed software package without requiring permission. In the same field of the endeavor, COLVIN discloses sending a registration message to a module registration system while allowing use of a licensed software package without requiring permission so that the registering of the licensed software package is substantially transparent to the user (abstract; paragraph 31-34;

Registration and authorization is provided transparent to the end user based on a counter. The system is recognizes authorized and unauthorized users and is able to take various actions including allowing the use of licensed software with or without requiring permission). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify HURST to include the transparent registration process taught by COLVIN, since such a modification would allow determination of use of shareware or timed software packages to be resolved automatically.

Regarding claim 27, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of HURST and COLVIN further discloses wherein a processor platform is operable to cause encryption of a data message prior to sending the data message (COLVIN – paragraph 21).

Regarding claim 29, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses wherein the registration message is formatted for a short message service (SMS) (paragraph 57, 61, 62).

Regarding claim 30, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses wherein the registration message is a wireless application protocol (WAP) (paragraph 57, 61, 62).

Regarding claim 32, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses wherein the registration message is formatted for a short message service (SMS) (paragraph 57, 61, 62).

Regarding claim 33, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses wherein the registration message is a wireless application protocol (WAP) (paragraph 57, 61, 62).

Regarding claim 36, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses wherein the module handler is operable to retrieve a stored value for the destination address from the module parameters, and wherein the module handler further comprises a default value for the destination address (paragraph 45-48, 57-59).

Regarding claim 37, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses wherein the module handler is operable to retrieve a stored value for the destination address from the module parameters, and wherein the module handler further comprises a default value for the destination address (paragraph 45-48, 57-59).

Regarding claim 38, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses wherein the module handler is operable to retrieve a stored value for the destination address from the module parameters, and wherein the module handler further comprises a default value for the destination address (paragraph 45-48, 57-59).

Regarding claim 39, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses wherein the module handler is operable to retrieve a stored value for the destination address from the

module parameters, and wherein the module handler further comprises a default value for the destination address (paragraph 45-48, 57-59).

Regarding claim 43, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses wherein the processing platform is further operable to select a delivery path for the registration message based on a stored delivery path parameter for the mobile device (paragraph 45-48, 57-59).

Regarding claim 44, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses wherein the module parameter further comprises a delivery path parameter (paragraph 45-48, 57-59).

Claims 7, 31, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over HURST et al (US 2003/0224823 A1) in view of COLVIN (US 2002/0162016 A1) and in further view of FREESE et al (US 5,148,472).

Regarding claim 7, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. Although HURST states that various messaging protocols can be used for transmitting an activation message (paragraph 57), the combination of HURST and COLVIN does not expressly disclose wherein the message comprises a series of dual-tone-multi-frequency (DTMF) tones, the destination address is a telephone number, and the sending of the registration message further comprises making a telephone connection to the telephone number. FREESE discloses wherein a registration message comprises a series of dual-tone-multi-frequency (DTMF) tones, a destination address is a telephone number, and the sending of the registration message further comprises making a telephone connection to the telephone number (col. 10, line

3-32). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of HURST and COLVIN to include DTMF registration, as taught by FREESE, since such a modification would allow the combination of HURST and COLVIN to use an established protocol format when communicating to a server.

Regarding claim 31, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. Although HURST states that various messaging protocols can be used for transmitting an activation message (paragraph 57), the combination of HURST and COLVIN does not expressly disclose wherein the message comprises a series of dual-tone-multi-frequency (DTMF) tones and the destination address is a telephone number. FREESE discloses wherein a registration message comprises a series of dual-tone-multi-frequency (DTMF) tones and a destination address is a telephone number (col. 10, line 3-32). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of HURST and COLVIN to include DTMF registration, as taught by FREESE, since such a modification would allow the combination of HURST and COLVIN to use an established protocol format when communicating to a server.
Regarding claim 40, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. HURST further discloses wherein the module handler is operable to retrieve a stored value for the destination address from the module parameters, and wherein the module handler further comprises a default value for the destination address (paragraph 45-48, 57-59).

(10) Response to Argument

Regarding the applicant's argument that "*Hurst discloses a system in which activation rather than registration is required. Hurst disclose a system in which activation rather than registration is required. Such activation is NOT transparent to the user and requires a response from the server in order to unlock the content. Hurst repeatedly refers to an "attempt" to access the secured content, and further teaches that the user must agree that they wish to use the content. Such a process is clearly not transparent to the user*" (see page 5 of the Appeal Brief); the examiner disagrees that such a process is not transparent to the user. Paragraph 48 discloses both an automatic and semi-automatic method of an Over-The-Air activation process. An example of an **automatic OTA activation initiation** is that the OTA activation occurs **without additional user intervention**, while an example of semi-automatic OTA activation initiation is where the OTA activation occurs by prompting the user for certain input or responses. Therefore, in a case where automatic OTA activation initiation, it is clear that such a process would be transparent to a user since activation occurs without additional user intervention.

Furthermore, while the applicant argues that Hurst shows a activation process instead of a registration process. It can be seen for example in the abstract, paragraph 4-8, and corresponding claims of the applicant's disclosure the registration process is used to authenticate an activation request, and therefore the authentication of Hurst can be seen as the registration process disclosed.

It is further noted, that the claim limitation argued recites the limitation "so that the registering of the licensed software package is **substantially transparent** to the user of the mobile device" (see lines 13 and 14 of the claim). HURST clearly states that no user intervention during an automatic activation is required (see paragraph 48 of HURST) and therefore describes at least **a substantially transparent** process of activation to a user.

Regarding the applicant's arguments that "*In the Advisory Action, the Examiner stated that an "automatic activation" in paragraph [0048] of Hurst is transparent to the user solely because there is "no additional user intervention." Applicants disagree. The "automatic activation" in Hurst is not transparent to the user. Indeed, even though no additional user intervention is required for the "automatic activation" in Hurst, the content must still be activated "when the user attempts to access the content and agrees he wants to use the content," and thus, the content cannot be used until activation is complete. See, for example, paragraphs [0047]-[0050] of Hurst (emphasis added). Thus, the user in Hurst must still wait for completion of the "automatic activation" prior to use the software. Such waiting for the software to be activated is apparent to the user because, for example, the user will have to wait for a certain amount of time before using the software and the user cannot immediately use the software.*" (see page 5 of the Appeal Brief, second paragraph); the examiner disagrees. As noted above the limitation states a substantially transparent process and therefore the automatic activation process is seen as a substantially transparent activation since no user intervention is required.

Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the applicant argues that waiting for the software to be activated is apparent to the user because, for example, the user will have to wait for a certain amount of time before using the software) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is the position of the examiner that transparency and substantial transparency is provided by the automatic activation process disclosed by Hurst.

In response to applicant's arguments against the references individually (see page 5, lines 27-page 6, line14), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Hurst discloses the invention of Claim 1, however fails to disclose a registration process while allowing use of the licensed software package without requiring permission. Colvin is used to show a process of registration while allowing use of the licensed software package without requiring permission. Therefore, the combination of Hurst in view of Colvin discloses the applicant's claim invention.

Regarding the applicant's arguments that *"[i]n fact, during initial use of the software in Colvin, the end user must contact an authorized representative to obtain the*

appropriate authorization code or password. See paragraph [0029]. It is difficult to imagine a process that is less transparent and automatic, or that teaches further away from the recitations of Applicants' claims." (see page 6, line 3-7); the examiner disagrees. While the applicant describes the manual communication and registration, Paragraph 29 further states with regards to the initial use of the software that "*Automatic communication may use similar methods or means to communicate the information but is* ***performed without user intervention****, although the user may be advised or notified that the process is occurring or has occurred*" (see lines 19-23 of paragraph 29). Therefore, both Hurst and Colvin teach automatic registration for software use.

Regarding the applicant's arguments that "*[t]he Examiner has pointed to language in paragraphs [0031] to [0034] of Colvin that refers to updating passwords or authorization codes automatically and transparently. However, these portions of Colvin are merely referring to periodic updates of authorization credentials, not the software itself* "(see page 6, line 7-10); the examiner disagrees. Paragraph 32, shows that the software must be authenticated based on an indicated counter. *The process may be accomplished automatically and transparently to the user*. (lines 6-9 of the paragraph). The system recognizes authorized and unauthorized users and is able to take various actions including allowing the use of licensed software with or without requiring permission (see paragraph 33).

In response to applicant's argument that *Applicant's claims are specifically directed to a software package being "initially accessed." The teachings of Colvin are not applicable to such a situation and thus, is non-analogous art* (page 6, line 9-13), it

has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the prior art of record and the applicant's endeavor relate to providing authentication and registration mobile device and a network element. Furthermore, both Hurst and Colvin teach automatic registration for software use, as discussed in the responses above.

Regarding the second grounds of rejection to be reviewed on appeal, the responses to the arguments are discussed above with regards to Hurst and Colvin.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Ariel Balaoing/

Examiner, Art Unit 2617

Conferees:

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